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10/761,833	01/21/2004	Mitchell K. Johnson	2004.01.008.WS1	4461
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			2637	

DATE MAILED: 09/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/761,833

Applicant(s)

JOHNSON, MITCHELL K.

Examiner

KHAI TRAN

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-20 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/21/04.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claim 8 is objected to because of the following informalities: Appropriate correction is required.

Regarding claim 8, line 3, the term "a test RF signal" should be --the test RF signal--.

Regarding claim 12, lines 5-6, the term "an RF signal" should be -- said RF signal--.

Claim Rejections - 35 USC § 112

2. Claims 4, 12, 15-16, 17-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 4, line 4, the term "the received signal strength indicator" lacks antecedent basis, as set forth in claim 12, line 4.

Regarding claim 15, line 11, the term "the received signal strength indicator" lacks antecedent basis, as set forth in claim 16, line 6.

Regarding claim 17, lines 14-15, "the received signal strength indicator" lacks antecedent basis.

Claims 18-20 are rejected by virtue of their dependency.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-2, 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Regnier et al (U.S. Pat. 4,590,477).

Regarding claim 1, Regnier et al disclose an RF receiver unit comprising an RF receive path that is capable of being coupled to an antenna that is capable of receiving an RF signal, an injection circuit for measuring RF signals in the RF receive path as shown in Figure 1, comprising: a circulator (103) coupled to the antenna (103) and coupled to the RF receive path; an injection source coupled to the circulator, wherein the injection source is capable of injecting a test RF signal (a test signal generator 107) into the circulator (103) (see Fig. 1, col. 2, line 63 to col. 3, line 5). Therefore, claim 1 is anticipated by Regnier et al.

Regarding claim 2, Regnier et al also disclose a switch (105) for selectively enabling and disabling the transfer of the test RF signal from the injection source to the circulator.

Regarding claim 7, Regnier et al disclose a directional coupler (208).

Regarding claim 8, Regnier et al disclose the injection source being coupled to the directional coupler and injecting a test RF signal into the directional coupler (see Fig. 1).

Regarding claim 9, Regnier et al disclose a switch (105) coupled to the circulator and coupled to the directional coupler (208).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 3, 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Regnier et al (U.S. Pat. 4,590,477) in view of Cope et al (U.S. Pat. 5,689,267).

Regarding claims 3, 11, Regnier et al fail to explicitly disclose the circulator having a reverse isolation of at least 20 dB.

Cope et al disclose the circulator comprising a reverse isolation of at least 20 dB (col. 2, lines 18-31). It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the reverse isolation in the circulator as taught by Cope et al into the teachings of Regnier et al for protecting damage caused by high energy level signals.

7. Claims 6, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Regnier et al (U.S. Pat. 4,590,477) in view of Cope et al (U.S. Pat. 5,689,267) as applied to claims 1, 7, 8, 9, 11 above, and further in view of Zybin (U.S. Pat. 6,195,036).

Regarding claims 6, 14, Regnier et al and Cope et al fail to disclose a duplexer coupled between the antenna and the circulator

Zybin discloses a duplexer (8 shown in Fig. 2) coupled between the antenna (7) and the circulator (4). It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the duplexer in the RF receiver coupled between the antenna and the circulator for reducing error signal.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6,704,352. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-14 of the instant application merely broadens the scope of the claims 1-16 of the U.S. Patent No. 6,704,352 by eliminating the elements and their functions of claims 1-16 of the U.S. Patent. It has been held that the omission an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 136 USPQ 184 (CCPA). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd.App.1969); omission of a reference element whose function is not needed would be obvious to one skilled in the art.

10. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

11. Claims 17-20 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 17-20 of prior U.S. Patent No. 6,704,352. This is a double patenting rejection.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bednekoff et al (U.S. Pat. 6,603,810) disclose a measurement and calibration circuit.

Masenten (U.S. Pat. 6,704,349) discloses a method an apparatus for canceling a transmit signal spectrum in a receiver bandwidth.

Johnson (U.S. Pat. 6,741,640) discloses a system and method for measuring the return loss of an antenna.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KHAIR TRAN whose telephone number is (571) 272-3019. The examiner can normally be reached on 7:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JAY PATEL can be reached on (571) 272-2988. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read 'Khai Tran', written in a cursive style.

KHAI TRAN
Primary Examiner
Art Unit 2637

KT
August 31, 2004